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EXAMINER
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GARTLAND, SCOTT D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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08/14/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,638	TRIVELY, MARTIN CHURCHILL	
	<b>Examiner</b>	<b>Art Unit</b>	
	SCOTT D. GARTLAND	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☒ Claim(s) 4, 13, and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status***

1. This Final Office Action is in response to the communication filed on April 13, 2009. No claims have been cancelled, claims 1-3, 10-15, and 19-21 have been amended, and no claims have been added. Therefore, claims 1-27 are pending and presented for examination.

### ***Response to Amendment***

2. Summary of the Response to Applicant's Amendment:
  - The objection to claims 4, 13, and 22 is maintained with further explanation being provided to clarify the issue regarding format and content of an offer.
  - The objection to claim 15 is withdrawn based on Applicant's amendment, although the Examiner notes that there is no argument or remark regarding the objection.
  - The rejection under 35 USC § 112, second paragraph, of claims 1-3, 10-12, and 19-21 based on the term "pre-provisioned" is withdrawn.
  - The rejection under 35 USC § 112, second paragraph, of claims 19 and 23 for "means for" language is maintained since no amendment or argument addresses the rejection. The Examiner has provided more explanation and detail below.
  - The Examiner maintains the rejection under 35 USC § 101 since Applicant's amendment does not overcome the rejection - further explanation is provided below.
  - Applicant's amendments do not overcome the prior art rejections under 35 USC §§ 102 and 103; therefore the Examiner maintains the rejections, but includes further citation and explanation in the rejections below.

### ***Claim Objections***

3. Claims 4, 13, and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims indicate the limitation of the offer code data defining the format and content of an entry, and the Examiner understands that when a promotional offer is sent, it must indicate with the offer the defined format and content required for entry - otherwise it would not be a valid offer, but just a suggestion. Applicant does not define in the written description what terms such as promotional offer, content required, and format entail – as such, the Examiner understands these terms to have their usual or common definitions and encompass the usual examples (without limiting the definition to the given examples): a promotional offer is any offer that promotes a product or idea, such as an advertisement, coupon, or discount; the content required would indicate the terms of the offer, such as time constraints, the value or discount of the offer, the product(s) covered by the offer, etc.; and the format would be the size, color, layout, etc. that relates the information (especially the required content) to the potential customer. The Examiner understands that in order to present an offer, such as an advertisement, coupon or discount, there must be some format and required content to constitute the offer. Therefore, since the promotional offer code data is previously required these claims do not further limit their respective parent claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Each of the claim elements of claims 19 and 23 is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner understands the functions of “inputting” an offer code” “accessing” data, etc. as occurring, but does not find an indication of a definition or structural limitation as to what is used to perform the function - for example, paragraphs 0010-0011 of Applicant's specification indicates a GUI as receiving offers and that offers may be received over-the-air, but does not indicate whether those inputs relate to offer codes, and paragraph 0017 indicates that the offer code may be input at manufacture, but not how - no means for input of the code is discussed. The other elements similarly do not reveal a definition of what the “means for” encompasses.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one

of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, a method/process claim must 1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not

in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

As to claim 10, it claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Claim 10 recites steps of inputting, accessing, associating, constructing, and transmitting, however, inputting, accessing and transmitting are extra-solution activities that do not tie a method to a particular machine or apparatus, and the associating and constructing steps are not positively recited as performed by the machine or apparatus (here, a mobile phone). The Examiner notes the amended "by the mobile phone" and "operable on a mobile phone," however, these phrases indicate that the user may be performing the actions through the use of the phone, rather than the phone performing a significant step. Therefore, the method is not tied to the machine or apparatus, and since no transformation of matter is occurring, claim 10 is directed to non-statutory subject matter.

Claims 11-18 depend from claim 10, but do not resolve the above issue; therefore these claims are also directed to non-statutory subject matter.

The Examiner suggests, in order to rectify this issue, amending claim 10 to indicate (assuming that it is within the inventors original conception, and that there is disclosure support) that the mobile phone is performing the associating and/or the constructing - preferably automatically performed by the phone, but certainly NOT performed by a user of the phone. In explanation: if the user could be performing those steps, then the device (phone) is considered a general purpose device that is no different from other devices, therefore the method is not tied to that particular device.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**6. Claims 1, 4-5, 7, 10, 13-14, 16, 19, 22-23, and 25 are rejected under 35**

**U.S.C. 102(a) and (e) as being anticipated by Barenbaum et al. (U.S. Patent Application Publication No. 2001/0039514, hereafter Barenbaum).**

Please note that, as a convenience to applicant, the Examiner has pointed out, by **bolding**, optional or intended use language, and included a note as to the ramifications of such language below.

Claim 1: Barenbaum discloses a mobile phone having a software application **for participating** in a promotional offer, said mobile phone comprising:

a processor (paragraph 0042, display the identifier; the Examiner notes that there must be a processor in order to direct the retaining and displaying; citation hereafter by number only);



a processor readable storage medium (0042, display the identifier; the Examiner notes that there must be storage in order to retain for display);

code recorded in the processor readable storage medium **to input** a promotional offer code into the mobile phone (0010, 0021, 0037, digital deal code and incentives; the Examiner also understands that phone software enabling a user to input the offer code (e.g. pressing “1” enters data, and pressing “2” enters different data, etc.) also satisfies this requirement, and must be present on enabled phones);

code recorded in the processor readable storage medium **to access** promotional offer code data that has been pre-stored in the mobile phone (0010, 0021, 0026, 0034, 0035; the Examiner understands that once the deal code or incentive is sent to the phone, it is stored at the phone, thus “pre-stored” before use of the deal code; the Examiner also understands that phone software enabling a user to access various menus and/or to display the digital deal satisfies this requirement), the promotional offer code data comprising parameters of a sponsor of a promotional campaign that awards prizes to winners of the promotional campaign (0021, 0024, 0026; the Examiner understands the incentive, or offer, or expiration date, as communicated by the data of the deal, to be parameters of a sponsor, and since more deals may be conveyed than are available, the winners are those that redeem the offer of the sponsor);

code recorded in the processor readable storage medium **to associate** an input promotional offer code with corresponding promotional offer code data (0026, authenticate redemption; 0034, enable communication; 0037, communicate code to receive incentive; the Examiner understands that associating the offer code and data is required in order to communicate a requested deal and also to redeem a deal or incentive);

code recorded in the processor readable storage medium **to construct** a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0025-0026; the Examiner understands a deal request or a communication of the deal code to a server to require constructing an entry); and

code recorded in the processor readable storage medium **to transmit** the promotional offer entry to the sponsor (0037; the Examiner notes that the client is the sponsor per 0021).

Claim 4: Barenbaum discloses the mobile phone of claim 1 wherein the promotional offer code data defines the format and content of a promotional offer entry (0037).

Claim 5: Barenbaum discloses the mobile phone of claim 4 wherein the code recorded in the processor readable storage medium **to construct** a specific promotional offer entry comprises:

code recorded in the processor readable storage medium **to create** a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

code recorded in the processor readable storage medium **to include** the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 7: Barenbaum discloses the mobile phone of claim 5 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim 10: Barenbaum discloses a method **operable on** a mobile phone that **allows** the mobile phone **to participate** in a promotional offer, said method comprising:

inputting a promotional offer code into the mobile phone (0010, 0021, 0037, digital deal code and incentives);

accessing, by the mobile phone, promotional offer code data that has been pre-stored in the mobile phone (0010, 0021, 0026, 0034, 0035; the Examiner understands that once the deal code or incentive is sent to the phone, it is stored at the phone, thus “pre-stored” before use of the deal code; the Examiner also understands that phone software enabling a user to access various menus and/or to display the digital deal satisfies this requirement), the promotional offer code data comprising parameters of a sponsor of a promotional campaign that awards prizes to winners of the promotional campaign (0021, 0024, 0026; the Examiner understands the incentive, or offer, or expiration date, as communicated by the data of the deal, to be parameters of a sponsor, and since more deals may be conveyed than are available, the winners are those that redeem the offer of the sponsor);

associating an input promotional offer code with corresponding promotional offer code data (0026, authenticate redemption; 0034, enable communication; 0037, communicate code to receive incentive; the Examiner understands that associating the offer code and data is required in order to communicate a requested deal and also to redeem a deal or incentive);

constructing, by the mobile phone, a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0025-0026; the Examiner understands a deal request or a communication of the deal code to a server to require constructing an entry); and

transmitting, by the mobile phone, the promotional offer entry to a promotional sponsor (0037; the Examiner notes that the client is the sponsor per 0021).

Claim 13: Barenbaum discloses the method of claim 10 wherein the promotional offer code data defines the format and content of a promotional offer entry (0037).

Claim 14: Barenbaum discloses the method of claim 13 wherein constructing a specific promotional offer entry comprises:

creating, by the mobile phone, a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

including, by the mobile phone, the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 16: Barenbaum discloses the method of claim 14 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim 19: Barenbaum discloses a mobile phone **for participating** in a promotional offer, said mobile phone comprising:

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means for inputting a promotional offer code into the mobile phone (0010, 0021, 0037, digital deal code and incentives);

means for accessing promotional offer code data that has been pre-stored in the mobile phone (0010, 0021, 0026, 0034, 0035; the Examiner understands that once the deal code or incentive is sent to the phone, it is stored at the phone, thus "pre-stored" before use of the deal code; the Examiner also understands that phone software enabling a user to access various menus and/or to display the digital deal satisfies this requirement), the promotional offer code data comprising parameters of a sponsor of a promotional campaign that awards prizes to winners of the promotional campaign (0021, 0024, 0026; the Examiner understands the incentive, or offer, or expiration date, as communicated by the data of the deal, to be parameters of a sponsor, and since more deals may be conveyed than are available, the winners are those that redeem the offer of the sponsor);

means for associating an input promotional offer code with corresponding promotional offer code data (0026, authenticate redemption; 0034, enable communication; 0037, communicate code to receive incentive; the Examiner understands that associating the offer code and data is required in order to communicate a requested deal and also to redeem a deal or incentive);

means for constructing a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0025-0026; the Examiner understands a deal request or a communication of the deal code to a server to require constructing an entry); and

means for transmitting the promotional offer entry to a promotional sponsor (0037; the Examiner notes that the client is the sponsor per 0021).

Claim 22: Barenbaum discloses the mobile phone of claim 19 wherein the promotional offer code data defines the format and content of a promotional offer entry (0037).

Claim 23: Barenbaum discloses the mobile phone of claim 22 wherein constructing a specific promotional offer entry comprises:

means for creating a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

means for including the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 25: Barenbaum discloses the mobile phone of claim 23 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 2-3, 6, 8-9, 11-12, 15, 17-18, 20-21, 24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barenbaum.**

Claim 2: Barenbaum discloses the mobile phone of claim 1 wherein the pre-stored promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 3: Barenbaum discloses the mobile phone of claim 1, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was embedded into the mobile phone by the manufacturer. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client

input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 6: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the code recorded in the processor readable storage medium to construct a specific promotional offer entry further comprises: code recorded in the processor readable storage medium to encrypt the message. Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.



Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

Claim 8: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 9: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches text and short

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message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 11: Barenbaum discloses the method of claim 10, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 12: Barenbaum discloses the method of claim 10, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was embedded into the mobile phone by a manufacturer of the mobile phone. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 15: Barenbaum discloses the method of claim 14 wherein constructing a specific promotional offer entry further comprises encrypting the message. Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

Claim 17: Barenbaum discloses the method of claim 14, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the

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various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 18: Barenbaum discloses the method of claim 14, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 20: Barenbaum discloses the mobile phone of claim 19, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and

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numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 21: Barenbaum discloses the mobile phone of claim 19, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was embedded into the mobile phone by the manufacturer. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input

data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 24: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein constructing a specific promotional offer entry further comprises encrypting the message. Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

Claim 26: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar

codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 27: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.



8. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements” and where the court interpreted the claimed phrase “said ferrule-forming member being crimpable onto said shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.... “[t]he ferrule or connector member is crimpable but not required, structurally, to be crimped .... These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.”)

The Examiner has analyzed the claim language and phrasing as indicated by the **bold** sections or words above, and determined that the phrasing following the **bolded** word(s) is not required due to the terminology being optional or intended use or expected results, in conformity with MPEP § 2111.04.

### ***Response to Arguments***

9. Applicant's arguments related to the objection to claims 4, 13, and 22 have been fully considered but they are not persuasive. Applicant does not define in the written

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description what terms such as promotional offer, content required, and format entail – as such, the Examiner understands these terms to have their usual or common definitions and encompass the usual examples (without limiting the definition to the given examples): a promotional offer is any offer that promotes a product or idea, such as an advertisement, coupon, or discount; the content required would indicate the terms of the offer, such as time constraints, the value or discount of the offer, the product(s) covered by the offer, etc.; and the format would be the size, color, layout, etc. that relates the information (especially the required content) to the potential customer. As such, given the common meaning of the terms used, and that Applicant has not defined those terms differently, the Examiner is not persuaded that claims 4, 13, and 22 further limit the parent claim(s).

10. The Examiner notes that no argument or amendment addresses the rejection of claims 19 and 23 regarding the use of “means for” language and whether 35 USC § 112, sixth paragraph is invoked; therefore the Examiner maintains the rejection and includes further explanation above.
11. The Examiner withdraws the rejection under 35 USC § 112, second paragraph, related to the term “pre-provisioned” since the term is removed by amendment. The Examiner understands “pre-stored” to indicate any form of storage before use or viewing – such as would be required for display or redemption.
12. Applicant argues that the amendment to claims 10-18 overcomes the rejection under 35 USC § 101, however, the Examiner notes that the amended phrasing still indicates

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that the steps being performed may be performed by the user via the mobile phone; therefore the phone is not performing a significant step that is not extra-solution activity and the Examiner maintains the rejection.

13. Applicant's arguments with respect to the prior art rejections of claims 1-27 have been considered but are moot since the arguments are addressed to the amended claim language. The Examiner understands that Applicant's amendment modifies the context and scope of other sections of the claim, and in trying to promote prosecution the Examiner includes various further explanations and interpretation clarifications in the above rejections.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is 571-270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D. G./  
Examiner, Art Unit 3622

/J. V./  
J.V.  
Examiner, Art Unit 3622

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622